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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,480	04/19/2004	Cassandre Michelle Fecht	DC4998CIP1	3304

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Dow Corning Corporation  
Intellectual Property Dept. - CO1232  
P.O. Box 994  
Midland, MI 48686-0994

EXAMINER
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GRAHAM, SHELLEY R

ART UNIT	PAPER NUMBER
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1612

MAIL DATE	DELIVERY MODE
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03/10/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/827,480	<b>Applicant(s)</b> FECHT ET AL.	
	<b>Examiner</b> SHELLEY R. GRAHAM	<b>Art Unit</b> 1612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.  
4a) Of the above claim(s) 8, 10, 13 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9, 11 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>1 sheet 26 Oct 2007, 1 sheet 19 April 2004.</u> | 6) <input type="checkbox"/> Other: ____.  |



## **DETAILED ACTION**

### ***Status of the Application***

#### ***Election/Restriction***

1. Applicant's election of Group I, Claims 1-10, 13-14 (in part) and 11-12, drawn to a composition comprising at least one hydrocarbyl functional organopolysiloxane and at least one cosmetic ingredient, with traverse, in the reply filed on 26 October 2007 is acknowledged.
2. Applicant withdrew claims 12 and 13, and canceled claims 8 and 10. Accordingly, claims 1-7, 9, 11 and 12 are examined on the merits herewith.
3. The requirement for election of a single disclosed species is withdrawn.
4. The requirement is deemed proper and is therefore made FINAL.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

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with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-7, 9, 11 and 12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 10/827,478. An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Long*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Although the conflicting claims are not identical, they are not patentably distinct from each other because the presently claimed invention overlaps with that claimed in the co-pending applications.

6. Claims 1-7, 9, 11 and 12 of the instant invention and claims of the copending applications are directed to a composition comprising a hydrocarbyl functional organopolysiloxane of the given formula and a cosmetic ingredient, household care ingredient, or a health care ingredient (e.g. a sunscreen agent). Thus, Claims 1-13 of '478 anticipated the instant claims.

7. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

***Lack of Written Description Rejections - 35 USC § 112 1<sup>st</sup>***

8. Claims 1-7, 9, 11 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

9. The “at least one ... household care ingredient” limitations lack written description of what chemicals or chemical structures that applicant had possession of at the time of invention. A chemical genus can be adequately described if the disclosure presents a sufficient number of representative species that encompass the genus. If the genus has substantial variance, the disclosure must describe a sufficient number of species to reflect the variations within the genus. See MPEP 2163.

10. These terms lack sufficient description in the specification and no evidence indicates which household care ingredients were known to the applicant. Therefore, the fact pattern indicates that Applicant was not in possession of the claimed compositions. In the absence of understanding the active ingredients, the artisan would have accepted that applicant was not in possession of the claimed invention.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

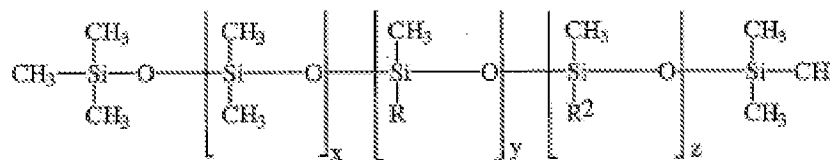
1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

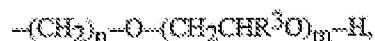
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12. Claims 1-7, 9, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over ROBINSON et al. (WO 02/03952, 17 January 2002) in view of BOLICH, JR. et al. (US 5965115).

13. With regard to claims 1-7, ROBINSON et al. teach compositions containing a skin care active ingredient in a delivery system comprised of a tacky solvent, a silicone elastomer and a carrier (see ROBINSON claim 1). Wherein the silicone elastomer is selected from dimethicone copolyol crosspolymer and dimethicone mixture, dimethicone/vinyl dimethicone crosspolymers, and mixtures thereof (see ROBINSON claim 3). Particular "dimethicone copolyols" are described on page 27, lines 3-17, as follows:



wherein R is C1-C30 straight, branched, or cyclic alkyl and R<sup>2</sup> is selected from:



and



wherein n is an integer from 3 to about 10; R<sup>3</sup> and R<sup>4</sup> are selected from H and C1-C6 straight or branched chain alkyl such that R<sup>3</sup> and R<sup>4</sup> are not simultaneously the same; and m, o, x, and y are selected such that the molecule has an overall molecular weight from about 200 to about 10,000,000, with m, o, x, and y being independently selected from integers of zero or greater such that m and o are not both simultaneously zero, and z being independently selected from integers of 1 or greater. It is recognized that positional isomers of these copolyols can be achieved. The chemical representations depicted above for the R<sup>2</sup> moieties containing the R<sup>3</sup> and R<sup>4</sup> groups are not meant to be limiting but are shown as such for convenience.



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14. The definition of the “dimethicone copolyols” of ROBINSON et al. meet the defined “hydrocarbyl functional organopolysiloxanes” of the instant claimed invention described in claims 1-7. ROBINSON et al. indicate that compositions of their invention may be included in “skin care products”, meaning both products that treat or care for the skin (page 3, lines 13-17).

15. While ROBINSON et al. does not define each and every polydiorganosiloxane listed in instant claim 3, one skilled in the art would have been motivated to use a variety of organopolysiloxanes available on the market. ROBINSON et al. indicate a number of organopolysiloxanes by commercial name, which would lead one skilled in the art to investigate further materials.

16. With regards to claims 1-7, ROBINSON et al. teach the use of a number of skin care actives in their composition, among which are listed in claim 8, farnesol, salicylic acid, pentapeptides and vitamin E derivatives.

17. With regards to claim 9, ROBINSON et al. teach that their composition can also contain a pigment (claim 6).

18. With regards to claims 11 and 12, ROBINSON et al. teach that their composition may be formulated into among others: lip gel, lip cream, and lip cosmetic (page 62, lines 13-17).

19. ROBINSON et al. does not mention that the compositions of their invention could be useful as household care ingredients.

20. BOLICH, JR. et al. teach of compositions containing an organopolysiloxane emulsion, a specific silicone polyoxyalkylene copolymer surfactant and a suitable carrier. BOLICH, JR. et al. state that the compositions of their invention may contain a variety of other ingredients, useful in preparing personal care products and household care products (column 14, lines 25-29).

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21. Given the above combined teachings, it would have been *prima facie* obvious to one of ordinary skill in the art to use the concepts of ROBINSON et al. combined with those of BOLICH, JR. et al. to produce compositions comprising a hydrocarbyl functional organopolysiloxane and at least one active ingredient for use in cosmetic, household care and health care compositions.

### ***Summary***

No claims were allowable.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley R. Graham, whose telephone number is 571-270-1563. The examiner can normally be reached on M-R 8am-3pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the

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Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SRG

11 February 2008

/Zohreh A Fay/

Primary Examiner, Art Unit 1612